

Appl. No. 10/719,224
Docket No. T-733 (Z-03480)
Amdt. dated June 11, 2007
Reply to Office Action mailed on April 16, 2007
Customer No. 27752

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REMARKS

Claim Status

Claims 7-10 have been canceled without prejudice. Claims 1-6 and 11-32 are currently pending in the application, of which claims 11-21 are currently withdrawn due to an earlier Restriction Requirement.

Rejections

35 U.S.C. § 112

Claims 24-32 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action states that "[c]laims 24-32 introduces new matter as the claims recites the limitation 'array'" and that "[t]he specification discloses 'one could apply two different compositions' on page 4 but does not describe the greater scope of an array" (*see* page 3). Applicants respectfully disagree.

Applicants note that the application is directed to the broad category of topical cosmetic compositions, without any explicit disclaimed species within this broad category. Moreover, the written description provides for 16 different product forms, stating that "the topical cosmetic composition of the present invention may be in the form of a liquid, lotion, cream, gel (including non-aerosol, aerosol, and self-foaming gel), foam, mousse, spray (aerosol or pump), paste or solid (e.g., stick or bar)... a solution, such as an aqueous or alcoholic or hydroalcoholic solution, or an emulsion, including both a water-in-oil emulsion and an oil-in-water emulsion" (*see* paragraph [0004] on page 2). Following this extremely broad product form disclosure, the written description provides a lengthy list of suitable carrier vehicles and additional ingredients—the skilled artisan could clearly take the explicit product form list and ingredient list and create a "large group of things," as the Examiner has interpreted the term "array." Furthermore, the application provides 6 different composition examples directed to a wide variety of different product types that includes 2 significantly different shaving compositions, an after-shave composition, a moisturizing lotion, a cleansing wash, and a cleansing bar. Lastly, the specification, in paragraph [0015] on page 4 states that "one could apply two different compositions within the scope of the present invention (e.g., a shaving gel and

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an aftershave lotion)." By employing the qualifier "e.g.", the explicit disclosure supports all of the combinations and permutations of the above-noted varying product forms and types. In view of the foregoing, Applicants request reconsideration and withdrawal of the Section 112 rejection.

35 U.S.C. § 103

Claims 1-6 and 24-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stoner et al. (U.S. Patent No. 5,902,574; hereinafter "Stoner") in view of Fike (U.S. 5,612,382; hereinafter "Fike") and Lisboa et al. (U.S. Patent No. 5,679,324; hereinafter "Lisboa"). Applicants respectfully disagree.

Independent claims 1 and 24 each recites, *inter alia*, a shave gel comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C. Thus, the claims require a very specific combination of vitamin A, vitamin E and aloe, along with an additional material(s) selected from another specific list of bisabolol, panthenol, vitamin B₃ and vitamin C. The applied references do not teach or suggest the specific combination of ingredients in the manner claimed.

Stoner discloses shaving preparations that employ a reducing agent to soften the protein structure of hair. Stoner also discloses a long list of optional additives, but is silent regarding any combinations or mixtures, much less the specifically claimed combination (*see* col. 5, lines 33-53). Vitamin A, vitamin E, and aloe are included in the long list of optional additives, but their combination (even two-way combination) is nowhere to be found. Furthermore, the examples are silent with regard to two of these three optional additives.

Fike discloses a pharmaceutical composition for transdermally delivering pharmaceutically active ingredients through skin or mucosal tissues (*see e.g.* Abstract). The pharmaceutical composition may contain vitamin B₃. Fike does not teach or suggest combining vitamin B₃ with any other vitamin or additive—certainly not the combination of vitamin A, vitamin E, and aloe.

Lisboa discloses aerosol foamable fragrance compositions. Lisboa discloses employment of bisabolol, but fails to teach or suggest its combination with a base mixture of vitamin A, vitamin E, and aloe. It is fair from clear how the Lisboa compositions are to be used. The Background section discusses aerosol shaving compositions that are well

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known in the art, but it also discusses personal care foam products other than shaving compositions (*see* column 1, lines 32-44). The remaining portions of the specification are silent regarding shaving compositions. Furthermore, the disclosure following the examples states that "[t]he compositions can provide a quick breaking foam which has an effective, long-lasting cooling sensation to the skin, low or zero noticeable stinging to the skin, including cut or irritated skin, and long-lasting smooth, moisturized skin feel" (*see* column 9, lines 42-46)—suggesting the compositions are to be used after shaving with a separate shaving composition.

Thus, in view of the above discussion, none of the applied references teach or suggest a shave gel comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C. The Office Action includes the following quote: "[i]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." Applicants submit however, that the applied references appear to have distinct purposes: Stoner is a shaving preparation, Fike is a pharmaceutical composition for transdermally delivering pharmaceutically active ingredients through skin or mucosal tissues, and Lisboa has indications for use as an aftershave composition. There is no apparent reason flowing from the applied references why a person of ordinary skill in the art of developing shave gels would have combined the prior art elements in the manner claimed. Following the decision of *KSR Int'l. Co. v. Teleflex, Inc.*, the USPTO issued a memorandum stating that "it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." Memo. From Margaret A. Focarino, Deputy Commissioner for Patent Operations, to Technology Center Directors, *Supreme Court decision on KSR Int'l. Co. v. Teleflex, Inc.* 2 (May 3, 2007) (*see* attached) (emphasis removed). The opinion itself required that "an apparent reason to combine...should be made explicit [by the examiner]." *Id.* (citing *KSR Int'l. Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

In view of the foregoing, Applicants request reconsideration and withdrawal of the Section 103 rejection.

Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of

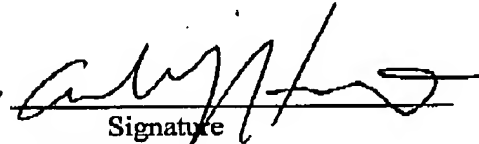
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the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of claims 1-6 and 22-32 are all respectfully requested.

Respectfully submitted,

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By



Signature

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent OperationsSUBJECT: Supreme Court decision on *KSR Int'l Co., v. Teleflex, Inc.*RECEIVED
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The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
- (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

- (3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.